



41

PTO/SB/21 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM***(to be used for all correspondence after initial filing)*

Application Number	09/820,747
Filing Date	March 30, 2001
First Named Inventor	Michael J. SINCLAIR
Art Unit	2863
Examiner Name	D. Pretlow
Attorney Docket Number	003797.00037

ENCLOSURES (check all that apply)

- | | | |
|---|---|---|
| <input type="checkbox"/> Fee Transmittal Form
<input type="checkbox"/> Fee Attached
<input type="checkbox"/> Amendment / Response
<input type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)
<input type="checkbox"/> Extension of Time Request
<input type="checkbox"/> Express Abandonment Request
<input type="checkbox"/> Information Disclosure Statement
<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers (for an Application)
<input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address
<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Request for Refund
<input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Request for Reconsideration |
|---|---|---|

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Jordan N. Bodner, Registration No. 42,338
-------------------------	---

Signature

Date

March 18, 2004

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name

Signature

Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of:

Michael J. Sinclair, et al.

Appln. No.: 09/820,747

Filed: March 30, 2001

For: CAPACITANCE TOUCH SLIDER

Atty. Docket No.: 003797.00037

Group Art Unit: 2863

Examiner: D.R. Pretlow

Confirmation No.: 4737

REQUEST FOR RECONSIDERATION

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the non-final Office Action mailed January 9, 2004 (paper no. 8), reconsideration and allowance are respectfully requested in view of the following remarks. Claims 1-10, 12-14, 16-20, and 22-26 remain pending.

Applicants appreciate the Examiner's indication that claims 1-10, 12-14, 18, and 24-26 are allowed.

Non-Art-Based Rejection

Claim 23 is rejected under 35 U.S.C. § 112, first paragraph, as not being enabled by the specification. In particular, the Office Action asserts that the specification does not describe first, second, third, and fourth capacitive nodes extending in an axial direction and interdigitated in the order claimed (first, then third, then second, and then fourth capacitive nodes) along a direction perpendicular to the axial direction. Applicants disagree. For example, the illustrative embodiment shown in Fig. 2C of the specification has a plurality of capacitive nodes including

capacitive nodes 206, 207, 208, and 209. Comparing claim 23 with these nodes, the claimed first capacitive node could be node 206, the second capacitive node could be node 208, the third capacitive node could be node 207, and the fourth capacitive node could be node 209. The first and second nodes (nodes 206 and 208) are commonly coupled to a first circuit node A, and the third and fourth nodes (nodes 207 and 209) are commonly coupled to a second circuit node B. Nodes 206, 207, 208, and 209 extend along an axial direction (in this example, left and right across the page). Nodes 206, 207, 208, and 209 are interdigitated along a direction perpendicular to the axial direction (in this example, up and down the page). They are interdigitated in the following order (as you scan from top to bottom in the figure): node 206 (the first capacitive node), then node 207 (the third capacitive node), then node 208 (the second capacitive node), and then node 209 (the fourth capacitive node). Also see the specification at, e.g., page 10, lines 17-21.

Applicants therefore respectfully submit that claim 23 is supported by the specification and is in compliance with 35 U.S.C. § 112, first paragraph.

Art-Based Rejections

Claims 22 and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,147,680 to Tareev ("Tareev"). Also, the Office Action sets forth what appears to be an obviousness rejection of claims 16 and 17 based on Tareev (beginning on page 2) that is unclear. During a telephone interview initiated by Applicants' representative, the Examiner clarified that the rejection is as follows. Claims 16, 17, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tareev in view of U.S. Patent No. 4,831,566 to Matthews et al. ("Matthews"). Applicants traverse all rejections.

Independent Claim 22

Independent claim 22 is directed to a device for measuring a position of a pointing member relative to the device *only in a single dimension*. Tareev, on the other hand, discloses a *two-dimensional touchpad array*. See, e.g., Tareev Figs. 1 and 2. Also note that Figs. 3 and 4 of Tareev are, respectively, the top and bottom orthogonal layers of the touchpad. Tareev, col. 2, lns. 39-42. Together, these two layers provide X and Y directional sensing for the touchpad. Thus, Tareev fails to teach or suggest a device for measuring a position of a pointing member relative to the device *only in a single dimension* as claimed. Claim 22 is therefore patentable over Tareev for at least this reason.

Further, claim 22 recites a groove formed in the insulating material and running axially in the single dimension. The Office Action concedes that Tareev fails to explicitly disclose such a groove, but asserts that such a groove would have been inherent to Tareev. Applicants respectfully disagree.

The fact that a certain characteristic *may* be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112. Inherency may not be established by probabilities or possibilities. MPEP 2112; *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The allegedly inherent characteristic must *necessarily* flow from the teachings of the applied prior art. MPEP 2112; *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). However, it is not necessary that Tareev has a groove. Many touchpads do not have grooves. Indeed, the touchpad of the laptop computer on which Applicants' representative is typing this very response is flat and has no groove whatsoever. Similarly, Tareev could easily be implemented as a flat, grooveless touchpad (such as shown in Fig. 1 of Tareev). Because it is not necessary that Tareev has a groove, it is not inherent that Tareev has a

groove. Even more so, it is not necessary that Tareev has a groove extending, not just in any arbitrary direction, but particularly in the axial direction relative to the capacitive nodes as recited in the claim.

Moreover, because Tareev is a two-dimensional touchpad array, Tareev actually teaches away from having such a claimed groove. It would appear to be hinder one's ability to arbitrarily move one's finger around (up, down, left, right, diagonally, along a curved path, etc.) on a two-dimensional touchpad if there were a groove in the way.

For at least these reasons, Tareev does not anticipate claim 22, and Applicants respectfully request withdrawal of the rejection.

Independent Claim 23

Independent claim 23 is directed to a device for measuring a position of a pointing member relative to the device. Like claim 22, the device of claim 23 includes a groove formed in the insulating material and running axially in an axial direction. As previously discussed, Tareev does not inherently have such a groove and actually teaches away from such a groove. Thus, Tareev does not anticipate claim 23, and Applicants respectfully requested withdrawal of the rejection.

Independent Claim 16

Independent claim 16 is directed to a device for measuring a position of a pointing member relative to the device. The claimed device includes first, second, third, and fourth capacitive nodes being disposed so as to be adjacent and interdigitated, wherein the pointing member interacts with at least one of the first, second, third, and fourth capacitive nodes, the first, second, third, fourth, fifth, sixth, seventh, and eighth capacitive nodes being disposed so as to be interdigitated, and each being substantially wedge-shaped. The Office Action asserts that it

would have been obvious to modify Tareev by replacing all of its nodes with the nodes of Matthews. Applicants respectfully disagree.

Tareev discloses a touchpad having an array of traces having extensions such as extensions 38 and 40 (Tareev Fig. 3). Tareev does not teach or suggest adjacent interdigitated wedge-shaped traces. Matthews also fails to teach or suggest what is missing from Tareev. Contrary to the Office Action's representation, Matthews discloses a wedge-*and-strip* pattern in a digitizer tablet surface. (Matthews, abstract). Fig. 3 of Matthews shows a first set of traces 60 having a wedge pattern and a second set of traces 50 having a strip (*not a wedge*) pattern. Matthews, col. 8, lns. 65-67. Matthew's second set of traces 50 are strip-shaped with parallel sides. (Matthews, Fig. 3).

The Office Action proposes that it would have been obvious to replace the traces of Tareev with the traces of Matthews in order to provide two-dimensional capability to Tareev. This motivation is not a proper basis to support an obviousness rejection since Tareev already had the capability of sensing in two dimensions, as previously discussed. Therefore, the Office Action has not offered a valid motivation to modify Tareev and has thus not made out a *prima facie* case of obviousness.

Even if modified as proposed, Tareev as modified would not have resulted in the claimed invention. Claim 16 requires that *each* of the claimed interdigitated capacitive nodes are wedge-shaped, not just some of them. However, only one of the two sets of interleaved traces in Matthews (and thus in the modified version of Tareev) are wedge-shaped. Therefore, the resulting structure would not have first, second, third, fourth, fifth, sixth, seventh, and eighth capacitive nodes being disposed so as to be interdigitated, and *each* being substantially wedge-shaped, as claimed.

For at least these reasons, claim 16 is allowable over Tareev and Matthews, either alone or in combination, and so Applicants respectfully request withdrawal of the rejection.

Independent Claims 19 and 20

Independent claims 19 and 20 are also allowable for at least similar reasons as those discussed above with regard to claim 16, and further in view of the differing features recited therein. Applicants note for the record that claim 19 does not contain recitations similar to those in claim 17, as stated in the Office Action on page 4. Applicants assume that the Office Action intended to refer to claim 16 and not claim 17.

Claim 17

Claim 17, which depends from claim 19, is also allowable for at least those reasons that claim 19 is allowable, and further in view of the additional features recited therein.

Conclusion

All rejections having been addressed, it is believed that this case is in condition for immediate allowance. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: March 18, 2004

By:



Jordan N. Bodner

Registration No. 42,338

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000